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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,633	11/18/2003	Walter A. Dorfstatter	GP-302837	4329

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EXAMINER

SOREY, ROBERT A

ART UNIT	PAPER NUMBER
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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/715,633	Applicant(s) DORFSTATTER, WALTER A.	
	Examiner ROBERT SOREY	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. Applicant's arguments, see the Appeal Brief filed on 09/26/2008, with respect to the rejection(s) of claim(s) 1 under 35 U.S.C. 103(a) have been fully considered; however, upon further examination and search, the Examiner has found it necessary to make new rejections and has applied more pertinent art in the process. New grounds of rejection are made as indicated in the Office action below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-4** are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular **machine**) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilsky, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); and Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied. This can be done, for example, by identifying the apparatus that

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accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

Applicant's method steps in claims 1-4 fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Furthermore, the method steps fail to transform underlying subject matter to a different state or thing. For example, claim 1 teaches sensing a vehicle incident, sending data to a service center, using the data to estimate vehicle damage, and using the estimate in an insurance process; but in no way is it clear as to how this is accomplished (such as, accomplished by a particular **machine**). It is recommended that Applicant simply add any structural language from the specification as necessary to complete a statutorily compliant method having Applicant's desired capabilities.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1, 2, and 5** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Court of Appeals for the Federal Circuit has set forth a number of factors

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(the “*Wands* factors”) to consider with regard to a lack of enablement, including:

- A. The breadth of the claims;
- B. The nature of the invention;
- C. The state of the prior art;
- D. The level of one of ordinary skill;
- E. The level of predictability in the art;
- F. The amount of direction provided by the inventor;
- G. The existence of working examples; and
- H. The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988). See MPEP § 2164.01(a)

6. As per claim 2, it is drawn to determining vehicle damage from delta velocity and vehicle information.

Factor A: The claim is overly broad, disclosing only that delta velocity is used in estimating vehicle damage.

Factor B: The invention is drawn to estimating vehicle damage by using vehicle delta velocity which is technically complex.

Factor C: The prior art cited PTO-892 show great detail demonstrating the level of ordinary skill in the art at the time the invention was made, and reveal that estimating vehicle damage from vehicle delta velocity and vehicle identification information was not well known.

Factor D: One of ordinary skill in the art must be mathematically skilled, and one of ordinary skill in the art would still not know how to estimate vehicle damage from vehicle delta velocity and vehicle identification information.

Factor E: The invention attempts to automate a manual process. Estimating vehicle damage is a subjective manual process typically done by adjustors in the

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insurance business or specialists in the automotive business. The prior results were unpredictable as they require imprecise human judgments.

Factor F: The inventor provides no direction. The specification refers to an "estimator" for receiving incident delta velocity and "utilizes this data along with the vehicle type information to determine an estimated damage value" by looking up the inputs in a database, but in no way is it made clear how this is done; what calculations, variables, inputs, and equations are involved; or even exactly what the variables are, except for that of delta velocity. A mere statement that it is done is insufficient to show possession.

Factor G: No working examples were provided.

Factor H: Based on the content of the disclosure, an undue amount of experimentation would be required to, in any way, estimate vehicle damage; therefore, an undue amount of experimentation would be needed to make or use the Applicant's invention.

7. As per **claims 1 and 5**, they are rejected similarly to claim 2, as they rely on vehicle sensors to estimate vehicle damage and are less specific.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 2** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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10. As per claim 2, Applicant teaches “obtaining an incident delta velocity from the vehicle incident”. It is unclear as to which incident delta velocity is being obtained. Is it the vehicle incident data from the vehicle that is having its damage estimated, or is it perhaps a second or third vehicle involved in the incident?

11. **Claims 1, 2, and 5** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See: MPEP § 2172.01. The omitted steps are: Applicant claims using incident data to automatically estimate vehicle damage (in claim 2, incident data is delta velocity), but the steps detailing how one uses said incident data to determine vehicle damage are missing. Applicant’s specification teaches only that an “estimator” makes estimate by looking up the input in a database, but no such database is known to exist, and the steps involved in looking up, calculating, and determining an estimated values based on incident data are missing.

Applicant Admitted Prior Art

12. **Note:** The MPEP states: “If applicant does not traverse the examiner’s assertion of official notice or applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate.” In the present case Official Notice was used to cover subject matter in claim 2, and in the reply filed by Applicant on 03/10/2008 and in the Appeal Brief filed 09/26/2008, no attempt was made by Applicant to traverse the official notice rejections; therefore, the material

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of claim 2 covered by the official notice in the office action dated 12/10/2007 is understood to be Applicant Admitted Prior Art.

Specifically, the limitation stated: *the claimed receiving a claim damage estimate*; and the Examiner took official notice “that an insurance carrier receiving a claim damage estimate for analysis is old and well known in the insurance industry. For example, when an insured customer is involved in an automobile accident, he or she may submit an estimate for repairs from the body or repair shop to the insurance carrier and thereby file a claim. Therefore, it would have been obvious at the time the invention was made to include claim damage estimate submission requirements to facilitate claims processing.”

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,141,611 to Mackey in view of U.S. Patent 6,694,234 to Lockwood.

15. As per claim 1, Mackey teaches a method for estimating vehicle damage, comprising the steps of:

--*sensing a vehicle incident* (Fig. 2, ele. 24)(see: Mackey, column 2, lines 46-47; and column 3, lines 10-21, is met by accident detector);

--automatically sending vehicle incident data to a service center (Fig. 1, ele. 16, 18, 19, 20, 25, and 27)(see: Mackey, column 2, lines 30-40; and column 3, lines 27-34, is met by transmission);

Mackey does not necessarily teach:

--using the incident data to automatically estimate [[a]] the vehicle damage;

--utilizing the estimated vehicle damage in a vehicle insurance decision process

Though Mackey teaches using vehicle incident data in an insurance related decision (Fig. 1, ele. 25)(see: Mackey, abstract; and column 1, lines 45-49, is met by data utilized by insurance adjuster immediately), Mackey does not necessarily teach estimating vehicle damage. However, Lockwood teaches estimating vehicle damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey and Lockwood. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, Lockwood teaches impact and acceleration/deceleration sensors in a vehicle (see: Lockwood, column 4, line 18 and lines 57-58), a server for responding to sensed data (see: Lockwood, column 6, lines 15-29), and estimating damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front

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quarter panel damage) for use in an insurance related decision (see: Lockwood, column 8, lines 33-35; and column 8, line 65 though column 9 line 4).

16. **Claims 2-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,141,611 to Mackey in view of U.S. Patent 6,694,234 to Lockwood in view of U.S. Patent Application Publication 2005/0108063 to Madill further in view of Applicant Admitted Prior Art.

17. As per claim 2, Mackey teaches a method for estimating vehicle damage, comprising the steps of:

--sensing a vehicle incident (Fig. 2, ele. 24)(see: Mackey, column 2, lines 46-47; and column 3, lines 10-21, is met by accident detector);

--obtaining an incident delta velocity from the vehicle incident (Fig. 2, ele. 24)(see: Mackey, column 2, lines 46-47; and column 3, lines 10-21, is met by accident detector including an accelerometer);

--sending the incident delta velocity to a service center (Fig. 1, ele. 16, 18, 19, 20, 25, and 27)(see: Mackey, column 2, lines 14-40; and column 3, lines 27-34, is met by transmission of stored vehicle accident data);

Mackey fails to specifically teach:

--at the service center, using the incident delta velocity with vehicle identification information to automatically estimate a vehicle damage value;

Though Mackey teaches using vehicle incident data in an insurance related decision (Fig. 1, ele. 25)(see: Mackey, abstract; and column 1, lines 45-49, is met by data utilized by insurance adjuster immediately), Mackey does not necessarily teach

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estimating vehicle damage. However, Lockwood teaches estimating vehicle damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey and Lockwood. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The limitation of *receiving a claim damage estimate*; is met by Applicant Admitted Prior Art.

Mackey also fails to teach:

--comparing the automatically estimated vehicle damage value to the claim damage estimate; and

--in response to the comparison, making an insurance claim-processing related decision.

However, Madill teaches a comparison of at least one data request element disclosed in a claim to additional insurance data (see: Madill, abstract). In addition, based on an assessment such as the one just mentioned, Madill teaches methodology for making investigatory insurance claim-processing related decisions (Fig. 3)(see: Madill, paragraphs 64-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mackey, Lockwood, Madill, and Applicant Admitted Prior Art. The well known elements described are merely

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a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, Lockwood teaches impact and acceleration/deceleration sensors in a vehicle (see: Lockwood, column 4, line 18 and lines 57-58), a server for responding to sensed data (see: Lockwood, column 6, lines 15-29), and estimating damage (see: Lockwood, column 8, line 64 through column 9, line 14, is met by total or right front quarter panel damage) for use in an insurance related decision (see: Lockwood, column 8, lines 33-35; and column 8, line 65 through column 9 line 4).

18. As per claim 3, Madill teaches the claimed step of *making an insurance claim-processing related decision includes requiring an insurance inspection if the automatically estimated vehicle damage value differs by more than a predetermined amount from the claim damage estimate* (307 and 309, Fig. 3)(see: Madill, paragraph 64, is met by the determination to take further investigative action based on a claim if certain indicators surpass a certain threshold).

19. As per claim 4, Madill teaches the claimed step of *making an insurance claim-processing related decision includes omitting an insurance inspection if the automatically estimated vehicle damage value is consistent with the claim damage estimate* as (307 and 311, Fig. 3)(see: Madill, paragraph 65, is met by the determination to not take further investigative action if certain indicators do not meet a certain threshold).

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20. As to claim 5, see discussion of claims 1 and 2 above as the system form of the claims 1 and 2 method elements are rejected here in a like manner.

21. As to claim 6, see discussion of claim 3 above as the system form of the claim 3 method elements are rejected here in a like manner.

22. As to claim 7, see discussion of claim 4 above as the system form of the claim 4 method elements are rejected here in a like manner.

Response to Arguments

23. In the Appeal Brief filed, 09/26/2008, Appellant makes the following arguments:

CLAIM 1 -

(A) That "one skilled in the art would not be led to combine these references [McMillan and Kidd]"; and

(B) "that the data sent to the central control is **not** the operator or driving characteristic data".

In response to Applicant's argument concerning claim 1, that (A), "one skilled in the art would not be led to combine these references [McMillan and Kidd]", Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's argument concerning claim 1, that (B), "that the data sent to the central control is **not** the operator or driving characteristic data", Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT SOREY whose telephone number is (571)270-3606. The examiner can normally be reached on Monday through Friday, 8:30AM to 5:00PM (EST).

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on (571)272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. S./

Examiner, Art Unit 3626

19 December 2008

/Robert Morgan/

Primary Examiner, Art Unit 3626